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Mailed:
July 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Edward J. Hennessey

Serial No. 76500430

Robert M. Skolnik, Esq. for Edward J. Hennessey.

Tricia Sonneborn, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Walters and Walsh, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Edward J. Hennessey has appealed from the final refusal of the Trademark Examining Attorney to register SURF WAX as a trademark for candles.¹ On March 17, 2003, applicant filed his application pursuant to Section 1(b) of the Trademark Act, based on an asserted intention to use the mark in commerce. The application was subsequently

¹ Application Serial No. 76500430, filed March 17, 2003.

approved by the Examining Attorney, and was published for opposition. Thereafter, a Notice of Allowance issued, and applicant filed a Statement of Use. When the Examining Attorney examined the Statement of Use, she determined that the specimen submitted therewith did not support the mark shown in the drawing. She advised applicant that he could not cure this problem by amending the drawing to ORIGINAL SURF WAX CANDLE, as this would be a material alteration of the mark shown in the drawing, and required that he submit a substitute specimen showing the mark as it appeared in the drawing. When applicant failed to do this, she issued a final Office action, and it is from this action that applicant has appealed.

The appeal has been fully briefed. Applicant originally requested an oral hearing, but later withdrew that request.

We note that there has been substantial argument about whether an amended drawing would be acceptable, or whether it would constitute a material alteration of the mark shown in the original drawing. We point out, as the Examining Attorney has done, that applicant never submitted an amended drawing, and therefore the issue of whether an amended drawing would have been acceptable is not before us. The Examining Attorney's comments regarding whether

the drawing could be amended were simply advisory: in the Office action requiring a specimen that would show use of the mark depicted in the drawing, the Examining Attorney simply advised applicant that he could not cure the deficiency in the specimen by amending the drawing.² Applicant also apparently acknowledges this, because in his reply brief he states that "if the appellant's position is sustained, the drawing is adequate." p. 3.

Trademark Rule 2.51(b) requires, in pertinent part, that in an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once a statement of use under §2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services. Thus, the question before us is whether the mark shown in the drawing, SURF WAX in standard character form, is a substantially exact representation of the mark as used. To determine this, we must look at applicant's specimen, reproduced below, since this is the only example he has provided of his use of the mark.

² The Examining Attorney also advised applicant that he could not withdraw the Statement of Use. Rule 2.88(g).

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The words SURF WAX appear as part of the central design element, under the picture which is bordered on the top by the name TED SHRED'S. SURF WAX borders this picture on the bottom, and is included in the phrase ORIGINAL SURF WAX CANDLE. It is the appearance of SURF WAX in the phrase that has raised the objection by the Examining Attorney. It is her position that consumers would not perceive SURF WAX as a separate mark, but would see it only as part of the phrase ORIGINAL SURF WAX CANDLE. Because, she asserts, applicant is attempting to separate out and register words that are an integral part of an entire phrase, the mark shown in the drawing, SURF WAX, is a mutilation of the actual mark, ORIGINAL SURF WAX CANDLE, and may not be registered.

In response, applicant relies on Section 807.14 of the Trademark Manual of Examining Procedure, which states that the drawing of the mark must be a substantially exact representation of the mark as actually used as shown by the specimen filed with the statement of use. Applicant does

not discuss why his drawing is a substantially exact representation, but goes on to quote extensively from Section 807.14(a) of the Trademark Manual, which concerns "material alteration" of a mark. The issue of material alteration, however, deals with whether an amended drawing would change the character of the mark shown in the original drawing. Although there is some relationship between the concepts of whether a mark shown in the drawing is a substantially exact representation of the mark shown in the specimen, and whether an amended drawing would be a material alteration of the mark shown in the original drawing, we reiterate that the issue of whether, if applicant had submitted an amended drawing, it would have been a material alteration of the mark, is not before us. Applicant DID NOT submit an amended drawing. The only issue we must consider is whether applicant's drawing for SURF WAX is a substantially exact representation of the mark shown on the specimen.³

The cases which have dealt with the question of whether a mark shown in the drawing is a substantially exact representation of the mark shown in the specimen have

³ Similarly, the question of whether SURF WAX is merely descriptive of the scent of a candle that smells like surf wax is not before us.

generally been concerned with whether the drawing is a mutilation of that mark. The question of mutilation, in turn, depends on whether the mark shown in the specimen can be considered a composite mark in which the element sought to be registered creates a commercial impression separate and distinct from the other elements of the mark. See *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983), and cases cited therein.

Viewing the mark as it appears on the specimen, we agree with the Examining Attorney that SURF WAX is depicted in the same size, color and type font as ORIGINAL and CANDLE, and even follows the same curve along the bottom of the picture. The commercial impression, therefore, is that of a unitary phrase, ORIGINAL SURF WAX CANDLE. Consumers would not view SURF WAX, as shown in this phrase, as a separate element. See *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999) (specimen, shown below, depicting figure of skater forming part of letter "M" in MILLER



(

does not support mark



shown in drawing); *In re San Diego National League Baseball Club, Inc.*, supra, (specimen showing SAN DIEGO PADRES REPORT, with SAN DIEGO, PADRES, and REPORT in three

different sizes and styles of lettering, with SAN DIEGO and PADRES more similar in size than PADRES and REPORT, and SAN DIEGO and PADRES grouped together on one line and REPORT on a separate line, does not support PADRES REPORT shown in drawing); and In re New Yorker Cheese Company, 130 USPQ 120 (TTAB 1961) (specimens showing words MARKA, DOBRA and SZYNKA in column superimposed on outline of Poland unacceptable to show use of applied-for mark DOBRA).

Applicant has argued that the words ORIGINAL and CANDLE in its specimen have no substantial or material effect on the mark. This argument was made in the context of applicant's position that the addition of these words would not be a material change to the mark SURF WAX. As we have already pointed out, the issue of whether an amendment to the drawing to depict the mark as ORIGINAL SURF WAX CANDLE is not before us because applicant did not submit an amended drawing. However, we have considered these arguments to the extent that they have an impact on the question of whether SURF WAX creates a separate commercial impression.

We agree that even though the word CANDLE is shown in the same type style, size and color as the other words, because it is a generic term it does not have any trademark significance whatsoever. Further, because generic terms do

not have to be included in trademarks (and, indeed, in many cases applicants have been required to disclaim generic matter), the fact that this word is not in the drawing does not affect the registrability of the applied-for mark. See *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989). However, the word ORIGINAL, as used in the mark, does have significance, such that it forms part of a unitary expression with SURF WAX. Applicant has asserted, without any evidence in support, that "original" is "so widely used." Brief, p. 9. Applicant merely states that "a recent search of the Trademark Office database records revealed approximately 6000 pending and registered marks having 'original' as part of the mark," *Id.*, but never made the results of such a search of record.⁴ In any event, even merely descriptive words that are used in a unitary phrase cannot be omitted from the drawing, such that only a portion of the phrase would be registered. See *In re Jane P. Semans*, 193 USPQ 727 (TTAB 1976), in which the Board rejected the contention of the applicant therein that the word "Krazy" was registrable apart from the composite

⁴ As an informational point, to be considered as evidence copies of the third-party registrations and applications (and not merely a search summary) would have had to be made of record during the prosecution of the application. Moreover, third-party applications have evidentiary value only to show that they were filed.

phrase "Krazy Mixed-Up," because of the descriptive nature of the term "Mixed-Up" for food seasonings.

In summary, we find that SURF WAX, as used as part of the phrase ORIGINAL SURF WAX CANDLE in the specimen, does not create a separate commercial impression, and therefore applicant has not submitted a specimen showing use of the mark SURF WAX which is depicted in the drawing.

Decision: The refusal of registration is affirmed.